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Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RONALD P. SANSONE

Appeal No. 2000-0376
Application 08/753,236¹

ON BRIEF

Before JERRY SMITH, BARRETT, and BARRY, Administrative Patent Judges.

BARRETT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the final rejection of claims 1-7 and 9-39.

We affirm-in-part.

¹ Application for patent filed November 22, 1996, entitled "System For The Enhancement Of Information Based Indicia And Postage Security Devices."

BACKGROUND

The disclosed invention is summarized in Appellant's brief at pages 3-5. The United States Postal Service (USPS) has published a proposed specification for an Information-Based Indicia (IBI) postal security device (PSD). The IBI is a special indicia containing information about the mail piece. The PSD is a unique security device that provides cryptographic security and performs the function of postage meter registers. The system includes a PSD manufactured by a meter manufacturer, a personal computer manufactured by a computer manufacturer, and a printer manufactured by a printer manufacturer. The meter manufacturer does not decide what printer and computer the user of the metering system will use. A problem exists where indicia cannot be read because of the printer. The disclosed invention records information about the printing parameters in or near the indicia which permits gathering information about printers, printer settings, paper envelopes, inks, and toners that cannot be read by IBI scanners and eventual elimination of printers and printing parameters that cannot be reliably read.

Appellant discloses that printing parameters include the manufacturer of the printer that printed the indicia, the printer model, the print density, the print dither type, envelope size, paper type, type of ink used to print the indicia, and toner type (specification, pp. 5-6).

Claim 1 is reproduced below.

1. An improved metering system that affixes an indicia to a mail piece, the improvement comprising: recording information relative to printing parameters of a printer that recorded the indicia on the mail piece, wherein the recorded information is recorded in the indicia or in the vicinity of the indicia to provide evidence of the printer printing parameters used to record the indicia.

THE PRIOR ART

The Examiner relies on the following references:

Chapman, Jr. (Chapman)	4,106,060	August 8, 1978
Kipphan et al. (Kipphan)	4,955,290	September 11, 1990
Bruns et al. (Bruns)	5,005,995	April 9, 1991
Johnsen	5,151,684	September 29, 1992
Dietrich	5,186,498	February 16, 1993
Kim et al. (Kim)	5,480,239	January 2, 1996
Billington	5,489,767	February 6, 1996
Morrison et al. (Morrison)	5,543,177	August 6, 1996
Smaha et al. (Smaha)	5,557,742	September 17, 1996
Cordery et al. (Cordery)	5,655,023	August 5, 1997
		(filed May 13, 1994)
Zabele	5,712,921	January 27, 1998
		(filed November 17, 1995)
Mizutani	5,774,146	June 30, 1998
		(filed August 30, 1996)
Schwartz et al. (Schwartz)	5,780,778	July 14, 1998
		(filed June 7, 1995)

Information Based Indicia Program Postal Security Device Specification, prepared for United States Postal Service (USPS) Engineering Center (June 13, 1996) (hereinafter Information Based Indicia Program or IBIP).

The main reference to Dietrich is summarized below.

Dietrich disclose a method of identifying a postage meter and monetary value stamping machine, which uses microprocessor-controlled printing methods, such as laser printing, dot matrix

printing, or thermal printing, that cannot be counterfeited (col. 1, lines 33-42). In microprocessor-controlled printing methods in postage meter and monetary value stamping machines, the material to be printed by stamping is produced by microprocessors, memories, and registers (col. 2, lines 21-24). The printing pattern or image is generated immediately before printing from stored data, such as printing block patterns and current data, like the date and amount of the fee (col. 2, lines 24-28). An identification characteristic identifying the postage meter and monetary stamping machine is also printed. To make the identification characteristic uncounterfeitable, parameters of the particular machine are linked with elements of the fee amount and date to be printed and encrypted (col. 2, lines 30-33). As shown in figure 1, the machine parameters MP, such as a serial number or factory number (col. 2, lines 36-37), a number of imprints with a date DT, a value setting VS, and optionally numbers of an advertising printing block (not shown) are linked by means of a cryptographic algorithm CA (called KA in the specification) to be incorporated into the printing pattern through printer control PC (called DS in the specification) (col. 2, lines 34-43). The encrypted number is said to be imprinted in the "open" (col. 1, lines 53-54; col. 2, line 60), which we interpret to mean part of the final assembled printing pattern, but separate from the part of the printing pattern

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indicating the usual postage meter information of date, amount of the fee, block patterns, etc.

THE REJECTIONS

Claims 1, 7, 9, and 16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Dietrich and Bruns.

Claim 2 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Dietrich, Bruns, and IBIP.

Claim 3 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Dietrich, Bruns, and Cordery.

Claim 4 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Dietrich, Bruns, Cordery, and either Johnsen or Schwartz.

Claim 5 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Dietrich, Bruns, Cordery, Kipphan, and either Johnsen or Schwartz.

Claim 6 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Dietrich, Bruns, and Official Notice that it was known to use human readable codes.

Claims 10, 11, and 39 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Dietrich, Bruns, Morrison, and Mizutani.

Claims 12-15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Dietrich, Bruns, and Morrison.

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Claims 17, 18, 25-28, and 30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Dietrich, Bruns, and Kim.

Claims 19-21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Dietrich, Bruns, Billington, and Chapman.

Claims 23, 24, 29, 32, and 33 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Dietrich, Bruns, Morrison, and Kim.

Claims 22, 31, and 34 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Dietrich, Bruns, Morrison, Mizutani, and Kim.

Claims 35 and 36 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Dietrich, Bruns, Kim, and Smaha.

Claims 37 and 38 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Dietrich, Bruns, and Zabele.

We refer to the final rejection (Paper No. 5) (pages referred to as "FR__") and the examiner's answer (Paper No. 12) (pages referred to as "EA__") for a statement of the Examiner's rejection, and to the appeal brief (Paper No. 11) (pages referred to as "Br__") for a statement of Appellant's arguments thereagainst.

OPINION

Grouping of claims

The claims within each ground of rejection are grouped to stand or fall together (Br7). One exception is claim 28. Although not really argued, it corresponds to a limitation in claim 5, which rejection is reversed, and we exercise our discretion to reverse the rejection of this claim separate from the other claims.

Claims 1, 7, 9, and 16 - Dietrich and Bruns

The Examiner finds that Dietrich does not mention "printing parameters" (FR2). The Examiner finds that Bruns discloses a system that records information relative to printing parameters of a printer to identify a printer component (the print wheel) (EA5). The Examiner concludes that it would have been obvious to modify Dietrich to include Bruns printing parameters because this would completely specify the machine and increase the number of parameters that a counterfeiter would have to manipulate to escape detection (EA5).

In the examiner's answer, the Examiner further finds (EA5) that Dietrich does not explicitly describe that the recording is "in the indicia or in the vicinity of the indicia." "Indicia" refers to the usual postage, date, place, etc. placed on a mail piece by a postage meter, and corresponds to the printing pattern

in Dietrich. Dietrich discloses that the machine parameters are assembled into the final imprint or printing pattern, which can be considered indicia, so the recorded information is in the indicia or in the vicinity of the indicia. Dietrich also discloses that the additional identification characteristics are imprinted in the open, which suggests that they are printed in the vicinity of, but separated from, the postal-related indicia. Thus, the limitation of recording information "in the indicia or in the vicinity of the indicia" is not a difference.

Bruns relates to a method of automatically identifying a print wheel to permit automatic control of printing parameters. Bruns discloses that printers may use a large number of print wheels and the print wheels may be arranged within cartridges which can interchangeably inserted into a printer. Bruns states the problem as follows (col. 1, lines 39-48):

Although both the print wheels and their associated cartridges have the same structure, printing conditions differ depending on the type or consistency of a print wheel, so that, when print wheels are to be exchanged, operating conditions on the side of the printer itself must be changed to correspond to the exchange of print wheels. For example, the imprint strength, pitch, ribbon advance and/or other parameters may need adjustment when changing print wheels to obtain satisfactory printing.

One piece of identifying information (e.g., data identifying the particular print wheel) is recorded on the print wheel by the angle α between a slot 17 indicating a zero position of the print wheel 1 and a stopping element (e.g., detent recess 32)

(figure 1). Two pieces of identifying information are recorded on the print wheel by using two stopping elements, such a recess 37 having side edges 38 and 39 disposed at angles $\alpha 1$ and $\alpha 2$ with respect to the slot 17 (figure 3). In the case of figure 3, the print wheel is rotated to the left and right to determine the identity codes $\alpha 1$ and $\alpha 2$ (figure 5), where the degrees are measured by counting clock pulses provided by scanning markings on a clocking disk on the printer wheel. With the aid of the two recorded identity codes $\alpha 1$ and $\alpha 2$, the control device (microprocessor) 35 in figure 4 obtains identification data from the memory 36 required to control print intensity, ribbon advancing step width, and other parameters of the printing device for the newly inserted print wheel (col. 8, lines 1-6). Thus, the operator need not perform any additional settings when a print wheel is exchanged for a new print wheel since the printer functions are automatically adapted to the set of type faces carried by the newly inserted print wheel (col. 6, lines 28-33).

The printing parameters in Bruns are stored in the microprocessor memory and are never printed out. The identity codes $\alpha 1$ and $\alpha 2$ are "recorded" on the printer wheel as angles between a slot 17 and stopping elements, but are never "recorded" in the sense of being printed out and are never part of anything which might be considered indicia. The identity codes $\alpha 1$ and $\alpha 2$ are used only to retrieve the printing parameters from memory for

automatically controlling the printer functions to adjust to the new print wheel. Because Bruns never prints out the identity codes or the printing parameters, we do not find any motivation for modifying Dietrich. The Examiner does not explain how this hardware coded information suggests modifying Dietrich.

Nevertheless, we find that claim 1 is anticipated by Dietrich. Anticipation is the epitome of obviousness. Dietrich affixes the usual postage information (indicia) to a mail piece. Dietrich records additional identification characteristics information regarding machine parameters, such as a serial number or factory number, which is either in the indicia (if indicia includes all information in the final printing pattern) or in the vicinity of the indicia (if indicia is only the postage information). The machines are postage meter and monetary value stamping machines using microprocessor-controlled printers (col. 1, lines 37-39) and, so, are broadly printers. Thus, the machine parameters are broadly printer parameters. The only question is whether the information regarding machine (printer) parameters in Dietrich constitutes "information relative to printing parameters of a printer" (emphasis added). Appellant discloses that the printing parameters include the manufacturer of the printer that printed the indicia and the printer model, in addition to information about the actual printing process, such as the print density, the print dither type, envelope size, paper

type, type of ink used to print the indicia, and toner type (specification, pp. 5-6). Thus, "printing parameters" must be interpreted, consistent with the disclosure, broadly enough to include machine hardware identification parameters as taught by Dietrich and is not limited to printing process parameters. Furthermore, it can be appreciated that the machine to which the machine parameter (e.g., serial number) is known to correspond broadly indicates printing parameters, such as whether the machine uses laser printing, dot matrix printing, or thermal printing (col. 1, lines 38-39). Appellant seems to admit that Dietrich is printing parameters of the entire machine (Br9).

Appellant's arguments do not demonstrate error. The description about how the disclosed invention works (Br9-10) is not persuasive because we do not find those limitations in the claimed invention. In particular, the limitation of "printing parameters" is broad enough to read on disclosed hardware parameters such as the manufacturer of the printer that printed the indicia and the printer model, which have nothing to do with the actual printing process. Appellant has not shown that the claimed "printing parameters" does not read on the serial number or factory number disclosed in Dietrich. Where later claims recite limitations having to do with the actual printing process, such as the printer settings (claim 5) and the type of toner (claim 14), we conclude that the Examiner has failed to establish

obviousness. The argument that Appellant's invention is not concerned with security (Br10) is not persuasive because the prior art need not suggest solving the same problem set forth by Appellant. See In re Dillon, 919 F.2d 688, 693, 16 USPQ2d 1897, 1901 (Fed. Cir. 1990) (in banc) (overruling in part In re Wright, 848 F.2d 1216, 6 USPQ2d 1959 (Fed. Cir. 1988)). However, we are not persuaded by the Examiner's reasoning that every modification in the dependent claims would have been suggested for reasons of improved security to prevent counterfeiting.

For the reasons stated above, we sustain the rejection of claims 1, 7, 9, and 16.

Claim 2 – Dietrich, Bruns, and IBIP

Claim 2 recites that the indicia is Information-Based Indicia. The Examiner finds that the IBIP proposes the use of Information-Based Indicia (IBI) (EA7). The Examiner concludes that it would have been obvious to implement the indicia in Dietrich as IBI in view of IBIP. The Examiner also concludes that it would have been obvious to modify Dietrich to use IBI because it aids in preventing and detecting counterfeiting and it increases the number of parameters that a counterfeiter would have to manipulate to escape detection (EA8).

Appellant argues that IBIP does not mention or anticipate that the IBI would not be able to be read due to the use of

incorrect printers, defective printers, or improper envelopes, and that this problem may be greatly reduced by the recording of printing parameters of a printer that recorded an IBI (Br12). It is argued that the claimed invention will save the consumer and the USPS money by informing them of the manner that the postal indicia was produced and this will reduce the number of unreadable indicia that are produced (Br13-14).

IBIP teaches recording indicia information as IBI. One of ordinary skill in the art would have been motivated to record the postal indicia of Dietrich as IBI if that was a recognized standard for indicia. Claim 2 requires no more than this. The additional identification characteristic in Dietrich could still be printed as an open imprint as part of the final printing pattern. Claim 2 does not recite any specific parameters relating to the process of printing the indicia and, so, Appellant's arguments about the disclosed invention are not commensurate in scope with the claim language. Accordingly, Appellant has failed to show error in the rejection. The rejection of claim 2 is sustained.

Claim 3 – Dietrich, Bruns, and Cordery

Claim 3 recites that the recorded information about the printer is the manufacturer of the machine used to print the indicia. The Examiner finds that this limitation is not taught

by Dietrich, but finds that Cordery discloses a method for marking mail with indicia identifying a manufacturer of the indicia stamping system, which is suggestive of identifying the machine manufacturer, and serves the same purpose of tracking the source of the indicia printing (EA8). The Examiner concludes that it would have been obvious to modify Dietrich to include the machine manufacturer because it aids in preventing and detecting counterfeiting and it increases the number of parameters that a counterfeiter would have to manipulate to escape detection (EA9).

Appellant argues that USPS regulations require that the manufacturer of a postal metering system identify the serial number of the meter that produced the indicia to reduce the possibility of fraud, but USPS regulations do not mention or anticipate that the manufacturer of the printer be included in the postal indicia (Br14). It is argued that Appellant is not concerned with the increase in security (Br14).

It seems that Appellant is trying to make a distinction between the manufacturer of the postal metering system and the manufacturer of the printer. The postal metering system of Dietrich includes a printer (col. 1, lines 38-39) and, thus, the manufacturer of the system is also "the manufacturer of the machine used to print the indicia," as claimed. Claim 3 does not require a printer separate from rest of the system as disclosed.

Cordery discloses recording indicia graphics indicating the manufacturer, such as the eagle design in figure 2 (col. 6, lines 9-11). Cordery also discloses recording a Vendor Identification Code 208 (manufacturer) and a Secure Portable Storage Device (SPSD) Identification (serial number) in a vicinity of the postal indicia (figure 2; col. 6, lines 35-40). While the manufacturer and serial number in Cordery are of the SPSPD, not the printer, Cordery does teach recording the manufacturer. Dietrich teaches recording the serial number or factory number information about the postal metering system, which includes a printer (col. 1, lines 38-39). In our opinion, the serial number or factory number in Dietrich must inherently identify the manufacturer because the USPS needs to be able to trace a machine back to a particular manufacturer, so claim 3 would have been obvious over Dietrich alone. However, we agree with the Examiner that it would have been obvious to record the postal metering system machine manufacturer in view of Cordery. The rejection of claim 3 is sustained.

Claim 4 - Dietrich, Bruns, Cordery, and either Johnsen or Schwartz

Claim 4 recites that the recorded information about the printer is the manufacturer and model number. The Examiner finds that these limitations are not taught by Dietrich. The Examiner concludes that it would have been obvious to record the

manufacturer in Dietrich in view of Cordery for the reasons stated with respect to claim 3 (EA9). The Examiner finds that Johnson teaches a tag device for attachment to an item of inventory that includes the model number of the item (EA9). The Examiner further finds that Schwartz discloses a postage system that detects unauthorized copying of software by checking the model number of the system during subsequent uses (EA10). The Examiner concludes that it would have been obvious to modify Dietrich in view of Johnsen or Schwartz to include the printer model number and machine manufacturer because it aids in preventing and detecting counterfeiting and it increases the number of parameters that a counterfeiter would have to manipulate to escape detection (EA9-10).

Appellant argues that claim 4 is not directed to a system that enhances security. It is described that some postal metering systems employ a Postal Security Device manufactured by a meter manufacturer, a personal computer manufactured by a computer manufacturer, and a printer manufactured by a printer manufacturer and that the meter manufacturer does not decide what printer and computer the user of the metering system will use (Br16). Appellant argues that he has discovered that the ability of the postal scanner to read postal indicia is dependent upon the printer because different model printers have different characteristics (Br16).

Appellant's arguments are not commensurate in scope with claim 4. Claim 4 requires only hardware information, not information relating to the actual printing process. Claim 4 does not require a separate Postal Security Device, computer, and printer. Nor does claim 4 recite any purpose or intended use for the recorded information.

Johnsen discloses a tag device attached to merchandise for the purpose of security, surveillance, pricing, tracking, accounting, and inventory control (abstract). The tag device 10 has a display panel 14 for displaying human readable text, such as the price and description, and a machine readable bar code (col. 4, lines 22-44). Each tag device can be provided with information such as a product model number, manufacturer vendor number, serial number, and purchase order number (col. 8, lines 28-31).

Schwartz discloses a postage scale system in which the user needs to enter a valid authorization number to enable the new application software (abstract; col. 10, lines 18-22). The authorization number includes an electronic signature, which is generated using the serial number, model number, and other parameters (col. 10, lines 22-34).

While both Johnsen and Schwartz disclose model numbers, neither suggests recording the model number of the printer as part of the information. It is not clear to us why one of

ordinary skill in the art would have looked to Johnsen for solutions to postage systems or how Johnsen suggests modifying Dietrich to arrive at the claimed invention. Nevertheless, one of ordinary skill in the art would have recognized that the serial number or factory number in Dietrich must identify everything needed by the USPS to be able to trace a machine back to a particular manufacturer, including manufacturer, model number, etc. Therefore, we conclude that it would have been obvious to provide information about the manufacturer and model number of the postal metering system in Dietrich, which includes a printer (col. 1, lines 38-39). The rejection of claim 4 is sustained.

Claim 5 – Dietrich, Bruns, Cordery, Kipphan, and either Johnsen or Schwartz

Claim 5 recites that the recorded information about the printer is the manufacturer, the model number, and the printer settings used to print the indicia. The Examiner concludes that it would have been obvious to record the manufacturer and model number in Dietrich in view of Cordery and either Johnsen or Schwartz for the reasons stated with respect to claim 4 (EA11). The Examiner finds that Kipphan discloses a method of assigning particular printer settings with the corresponding printer (EA11). The Examiner concludes that it would have been obvious to modify Dietrich in view of Kipphan to include printer settings

because it aids in preventing and detecting counterfeiting and it increases the number of parameters that a counterfeiter would have to manipulate to escape detection (EA11-12).

Appellant makes generally the same arguments as with respect to claim 4, except that printer settings is mentioned (Br17).

Kipphan discloses a system for associating a single ink density measuring device with a group of printing machines that are typically of different construction or models (col. 5, lines 3-6) and for remotely controlling printing machines with a common ink measuring device (col. 2, lines 64-67). Kipphan discloses that mechanical machine characteristics include various parameters and settings (col. 2, lines 24-31).

However, Kipphan does not suggest recording information about the printer settings used to print the indicia. It is not clear to us why one of ordinary skill in the art would have looked to Kipphan for solutions to postage systems or how Kipphan suggests modifying Dietrich to arrive at the claimed invention. We disagree with the Examiner's reasoning that it would have been obvious to record any kind of information for reasons of security and to prevent counterfeiting. The only motivation we find for recording information about the printer settings used for printing the indicia is found in Appellant's disclosure. We conclude that the Examiner has failed to establish a prima facie case of obviousness as to the limitation of recording information

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about the printer settings used to print the indicia. The rejection of claim 5 is reversed.

Claim 6 – Dietrich, Bruns, and Official Notice

Claim 6 recites that the recorded information about the printer is recorded in human readable code. The Examiner takes Official Notice that it was known to use human readable codes (FR8; EA12). The Examiner concludes that it would have been obvious to modify Dietrich to record machine parameters in human readable code to allow trusted personnel to recognize the recorded information (EA12).

Appellant makes a shorter version of the arguments made with respect to claim 4, except that human readable code is mentioned (Br18).

Appellant does not point out error in the Examiner's position that recording information in human readable code would have been obvious. Dietrich itself indicates that the encrypted number is imprinted in the open, which suggests that the number is printed in human readable form, probably something like the row of numbers 206, 208, 210, 214, 216, and 217 in figure 2 of Cordery. Perhaps the reason Appellant does not argue error in the Examiner's position is that printing machine information in human readable code was well known. In any case, Appellant has failed to show error. The rejection of claim 6 is sustained.

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Claims 10, 11, and 39 – Dietrich, Bruns, Morrisen, and Mizutani

Claim 10 recites that the recorded information indicates the type of paper on which the indicia was printed. Claim 39 recites that the printing parameters include information about the supplies that the printer used to record the indicia. The Examiner finds that Morrison discloses marking paper using special inks and Mizutani discloses a sensor that discriminates between different types of paper (EA13). The Examiner concludes that it would have been obvious to modify Dietrich and Bruns to use the Morrisen inks for added security (EA13) and that it would have been obvious to incorporate a Mizutani sensor in the combination to detect the type of paper and convey the result in the indicia (EA13). The Examiner concludes that it would have been obvious to modify Dietrich in view of Morrison and Mizutani to indicate the type of paper on which the indicia is printed because it aids in preventing and detecting counterfeiting and it increases the number of parameters that a counterfeiter would have to manipulate to escape detection (EA14).

Appellant argues that the claims are not directed to providing added security, but record information about the type of paper to determine print quality (Br19). It is argued that the print quality may be improved if one knows the printing parameters and the type of paper used to record the indicia (Br19).

Morrison discloses marking materials containing retroreflective fillers. Copies or marks using such material can be readily identified, which can permit subsequent identification of the source of the image (the type of machine, the facility where the copy was made, or the specific machine unit) (col. 43, lines 15-25, referred to by the Examiner). Different materials allow distinguishing between different kinds of marks (col. 43, lines 36-42, referred to by the Examiner). Other uses of the reflective material are described at column 2, lines 32-65.

Mizutani discloses discriminating a kind of paper by performing one or more operations (col. 3, lines 52-63, referred to by the Examiner). The sensed type of paper permits selection of the appropriate color conversion table (abstract).

Neither Morrison nor Mizutani suggests recording information about the type of ink or the type of paper in the indicia; the only teaching for these limitations is in Appellant's disclosure. We disagree with the Examiner's reasoning that it would have been obvious to record any kind of information for reasons of security and to prevent counterfeiting. Accordingly, the Examiner has failed to establish a prima facie case of obviousness. The rejection of claims 10, 11, and 39 is reversed.

Claims 12-15 - Dietrich, Bruns, and Morrison

Claim 12 recites that the recorded information indicates the type of ink that was used to print the indicia. The Examiner relies on the same reasoning as for claim 10 (EA14). For the reasons discussed in connection with claim 10, we reverse the rejection of claims 12-15.

Claims 17, 18, 25-28, and 30 - Dietrich, Bruns, and Kim

Claims 17 and 18

Claim 17 recites that the reading machine is a scanner.

The Examiner finds that Kim discloses a scanner used to determine the validity of an indicium on a mail piece (FR10; EA15). The Examiner concludes that it would have been obvious to use a scanner as the reading means for reading the recorded information in Dietrich because using a scanner allows one to determine the validity of the recorded information and because it aids in preventing and detecting counterfeiting and it increases the number of parameters that a counterfeiter would have to manipulate to escape detection (EA15).

Appellant argues the disclosed invention rather than the invention broadly claimed in claim 17 (Br21-22).

The indicia and the additional identification characteristics in Dietrich have to be read somehow and Kim teaches that it was well known to use a scanner to read the

printed information on a mail piece. We conclude it would have been obvious to read the indicia and additional identification characteristics in Dietrich using a scanner as taught by Kim to automate the reading process. The Examiner's reasons about counterfeiting seem inapplicable to the use of a scanner. Nevertheless, the combination of Dietrich and Kim provides sufficient evidence to establish a prima facie case of obviousness. The rejection of claims 17 and 18 is sustained.

Claims 25-28 and 30

Independent claim 25 recites recording information relative to characteristics of the printer that recorded the indicia and reading the recorded information to determine whether or not the recorded information indicates that a printer recognized by the Postal Service recorded the indicia.

The Examiner finds that Kim discloses a scanner used to determine the validity of an indicium on a mail piece (EA16). The Examiner concludes that it would have been obvious to implement the indicia reading of Dietrich with the system of Kim to indicate whether or not a printer recognized by the USPS printed the indicia (EA17). The Examiner concludes that it would have been obvious to modify Dietrich and Bruns in view of Kim because it aids in preventing and detecting counterfeiting and it

increases the number of parameters that a counterfeiter would have to manipulate to escape detection (EA17).

Appellant argues that he is not detecting a machine approved by the Postal Service in order to allow the Postal Service to make use of the resulting security system, but so that printers that have not been approved will not be used (Br22). It is argued that Appellant's invention is concerned with the print quality of the printer that printed the indicia (Br22).

Kim discloses generating graphic indicia image information from a composite of types of information (figure 3) and printing the image using a computer driven printer having either a customized printer driver or a custom printer to modify the dot size, or the column or row spacing of the dots for the purpose of preventing counterfeiting. Kim discloses that the indicia is scanned at a postal facility to detect whether or not the indicia is valid (figure 4).

Step a) is taught by Dietrich because, as discussed in connection with the rejection of claim 1, the "information relative to characteristics of the printer that recorded the indicia" is broad enough to read on the machine parameters recorded in Dietrich because the postage meter and monetary value stamping machines in Dietrich include a printer and "characteristics of the printer" is disclosed as including hardware characteristics such as the manufacturer and model

number, which are analogous to the serial number and factory number in Dietrich. Kim teaches determining whether the indicia is valid, although this teaching is implicit in the purpose of the invention of Dietrich . Among other things, determining whether the indicia is valid suggests determining whether or not the postage meter system (which includes a printer) is recognized by the Postal Service. Thus, we conclude that step b) would have been obvious over Kim. Claim 25 does not require a printer separate from a computer and PSD. Claim 25 does not recite that the purpose of determining whether a printer is recognized is concerned with print quality, as argued, or is intended to prevent non-approved printers from being used, as argued. Thus, Appellant's arguments are not persuasive. The rejection of claims 25-27 and 30 is sustained.

Although Appellant merely mentions the limitations of claim 28, which is not considered an argument as to error in the Examiner's rejection as required by 37 CFR § 1.192(c)(8)(iv), since claim 28 recites the same limitation found in claim 5, we exercise our discretion and reverse the rejection of claim 28 for the reasons stated in the analysis of claim 5.

Claims 19-21 – Dietrich, Bruns, Billington, and Chapman

Claim 19 recites first means for reading the recorded information about the machine that recorded the indicia, second

means for reading the indicia if the first means are unable to read the indicia, and means for determining whether or not the indicia was damaged.

The Examiner finds that Chapman discloses (at col. 4, lines 66-68) a mailing system having a scanner which rereads a portion of the document if there is an error in the first attempted reading (EA18). The Examiner finds that Billington discloses an indicia system that includes an error detection code as a means for determining whether or not the indicium was damaged (EA18). The Examiner concludes that it would have been obvious to use the system in Chapman to prevent unnecessary interruptions and to use the system in Billington to determine whether indicia has been damaged (EA18). The Examiner concludes that it would have been obvious to modify Dietrich and Bruns in view of Chapman and Billington because it aids in preventing and detecting counterfeiting and it increases the number of parameters that a counterfeiter would have to manipulate to escape detection (EA18-19).

Appellant argues that he records and reads information about the printing parameters to determine print quality (Br23).

Claim 19 does not recite the purpose of determining print quality, but merely requires structure for reading and detecting damaged indicia. Appellant does not point out the error in the Examiner's proposed modification of Dietrich. We do not agree

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with the Examiner's reasoning about preventing counterfeiting, but the Examiner has provided other reasons for the modification, which have not been shown to be in error. Accordingly, the rejection of claim 19 is sustained.

Appellant notes the limitations of claims 20 and 21, but does not state what the error is in the Examiner's rejection as required by 37 CFR § 1.192(c)(8)(iv). Accordingly, the rejection of claims 20 and 21 is sustained.

Claims 23, 24, 29, 32, and 33 – Dietrich, Bruns, Morrison, and Kim

Since claims 23 and 24 depend on claims 13 and 15, respectively, and the rejection of these claims has been reversed, the rejection of claims 23 and 24 is reversed.

Claim 29 recites the material used to record the indicia, claim 32 recites printing information about the ink, and claim 33 recites printing information about the toner. The Examiner relies on the reasoning used in the rejection of claims 12, 14, 27, and 30 (EA20).

Because the references do not disclose or suggest recording information regarding the type of ink, toner, or material used to record the indicia, as discussed in the rejection of claims 12-15, the rejection of claims 29, 32, and 33 is reversed.

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Claims 22, 31, and 34 – Dietrich, Bruns, Morrison, Mizutani,
and Kim

Claim 31 recites printing information about the paper. The Examiner relies on the reasoning used in the rejection of claims 10 and 17 (EA20). Because the references do not disclose or suggest recording information about the material used to record the indicia, as discussed in the rejection of claim 10, the rejection of claim 31 is reversed.

Since claims 22 and 34 depend on claims 10 and 33, respectively, and the rejections of these claims have been reversed, the rejection of claims 22 and 34 is reversed.

Claims 35 and 36 – Dietrich, Bruns, Kim, and Smaha

Claim 35 recites copying the recorded information for future reference.

The Examiner finds that Smaha discloses a system for detecting misuse of a data processing that creates an output report about the detected misuse, referring to column 3, lines 19-21 and 40-43 (EA21). The Examiner concludes that it would have been obvious to modify Dietrich in view of Bruns, Kim, and Smaha because it aids in preventing and detecting counterfeiting and it increases the number of parameters that a counterfeiter would have to manipulate to escape detection, and allows the USPS to make use of the resulting security system (EA21).

Appellant argues that the recorded information is relative to the characteristics of the printer that printed the indicia (Br25).

We do not find where Smaha suggests copying the recorded information as claimed. That it was known, in general, to copy and generate a report is not sufficient to meet the limitations of claim 35. The Examiner's general reasoning about preventing counterfeiting as a motivation is not persuasive. We conclude that the Examiner has failed to establish a prima facie case of obviousness. The rejection of claims 35 and 36 is reversed.

Claims 37 and 38 – Dietrich, Bruns, and Zabele

Claim 37 recites that the printer records the status of the printing parameters just prior to printing.

The Examiner finds that Zabele discloses a printer recording the status of the printing parameters (EA22). The Examiner concludes that it would have been obvious to modify Dietrich to record resolution relative to the resolution used, whereby the printer records the status of the resolution used to record the indicia just prior to printing (EA23). The Examiner concludes that it would have been obvious to modify Dietrich in view of Bruns and Zabele because it aids in preventing and detecting counterfeiting and it increases the number of parameters that a

counterfeiter would have to manipulate to escape detection and affords print quality control (EA23).

Zabele discloses a system and method for controlling print quality. An electronic test image of the printed image is acquired by an image acquisition unit and compared to a prototype image of the desired printed image and an alarm is generated if the printing on the test image and the printing on the prototype image do not satisfy a predetermined condition (col. 1, line 58 to col. 2, line 3). We fail to see how the portions of Zabele pointed out by the Examiner can be considered the "status of the printing parameters" in any sense. The Examiner's reasoning regarding counterfeiting is again not persuasive. Accordingly, the Examiner has failed to establish a prima facie case of obviousness. The rejection of claims 37 and 38 is reversed.

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CONCLUSION

The rejections of claims 1-4, 6, 7, 9, 16-21, 25-27, and 30 are sustained.

The rejections of claims 5, 10-15, 22-24, 28, 29, and 31-39 are reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

JERRY SMITH)	
Administrative Patent Judge)	
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LANCE LEONARD BARRY)	
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